

## **REMARKS**

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-17 and 19, the only claims pending and under examination at this time following entry of the above amendments.

### ***Formal Matters***

Claim 1 is amended. Support for this amendment may be found throughout the specification and claims as originally filed, specifically at page 7, paragraph 32 and page 14, paragraph 54. Claim 18 is cancelled without prejudice. As no new matter has been added, entry of the above amendments is respectfully requested.

### ***Rejection under 35 U.S.C. §112- second paragraph***

Claims 1-19 stand rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Office action states that although the preamble recites a method of detecting a molecule of interest, the body of the claim fails to recite a step of detecting such a molecule. Claim 1 is amended to refer to a method of detecting a complex. Accordingly, in light of this amendment, this rejection may be withdrawn.

### ***Rejection under 35 U.S.C. §102(b)***

Claims 1-8, 10, 11, 17 and 19 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Fox (WO 01/14591). Claim 1 is amended to include the limitations of Claim 18, which claim was not included in this rejection. Accordingly, this rejection may be withdrawn.

Claims 1-8, 10, 11, 17 and 19 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Baselt (US 5981297). Claim 1 is amended to include the limitations of Claim 18, which claim was not included in this rejection. Accordingly, this

rejection may be withdrawn.

***Rejection under 35 U.S.C. §102(e)***

Claims 1-8, 10, 11, 14-17 and 19 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by Coehoorn (WO 03/054523). Claim 1 is amended to include the limitations of Claim 18, which claim was not included in this rejection. Accordingly, this rejection may be withdrawn.

Claims 1-8, 10, 11, and 14-15 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by Terstappen (US 6623983). Claim 1 is amended to include the limitations of Claim 18, which claim was not included in this rejection. Accordingly, this rejection may be withdrawn.

***Rejection under 35 U.S.C. §103(a)***

Claims 9, 12, and 13 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Fox, or Baselt or Coehoorn in view of Berning (US 2005/0025969). Claim 1 is amended to include the limitations of Claim 18, which claim was not included in this rejection. Claims 9, 12 and 13 are all dependent on Claim 1. As such, this rejection may be withdrawn.

Claims 16 and 18 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Fox or Baselt in view of Li (Journal of Applied Physics, 93(10):7557-7559; (2003).

The instant application claims priority to provisional application 60/519,378 which was filed on November 11, 2003. The Li et al. (May 2003) publication occurs less than one year prior to the date of application for patent in the United States. Accordingly, Li et al. (May 2003) is only available as prior art to the present application under §102(a).

Li et al. (May 2003) is a publication in which the four co-inventors (Shan X. Wang, Robert L. White, Chris D. Webb and Guanxiong Li) are all named. With respect

to the such publications, the MPEP at section 715.01(c) states:

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Enclosed is a declaration under 1.132 establishing that the Li et al., publication describes the Applicants' own work in the present application.

Accordingly, Li et al (May 2003) is not available as prior art for a §103(a) rejection. As such, the rejection of Claims 16 and 18 under 35 U.S.C. §103(a) as allegedly unpatentable over Fox or Baselt in view of Li (Journal of Applied Physics, 93(10):7557-7559; (2003) may be withdrawn.

Claim 18 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Coehoorn in view of Li. Claim 18 is cancelled without prejudice. This rejection is thus moot and may be withdrawn.

**CONCLUSION**

Applicants submit that all of the claims are now in condition for allowance, which action is requested. If the Examiner finds that a Telephone Conference would expedite the prosecution of this application, he is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any other fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number STAN-571.

Respectfully submitted,  
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